

With respect to Way, Applicant notes that claim 34 requires zirconium. However, Way does not comment on zirconium. Accordingly, Way cannot suggest this claimed limitation. Furthermore, claim 43 requires at least 4% vanadium while Way provides no teaching on vanadium content and certainly does not suggest at least 4% by weight. Accordingly, Way does not overlap nor suggest the presently claimed invention in several instances.

Furthermore, although niobium/columbium and vanadium are included in a laundry list of potential ingredients of Way, none are exemplified in any of the specific embodiments. Similarly, although manganese is included in a few of the examples, it is not mentioned within the general description of the Way composition. Accordingly, there is no disclosure in the Way document which suggests the presently claimed combination of elements. More specifically, the only ability to read the Way document as overlapping the presently claimed invention is to pick and choose from its claims, examples, or the broad disclosure at column 2, lines 30-43. Moreover, not one of these sections of the patent individually overlap, the present invention.

More specifically, if we look at the disclosure at column 2, the reference fails to teach the presently required vanadium, niobium and manganese constituents. Referring to the examples, Example I lacks tungsten, vanadium, niobium; Example II lacks boron, niobium, vanadium tungsten; Example III lacks iron, boron, niobium, molybdenum, vanadium; Example IV lacks tungsten, vanadium, niobium; Example V lacks tungsten, vanadium, niobium, iron; Example VII lacks vanadium and niobium; Example VIII lacks tungsten, vanadium, niobium, iron; Example IX molybdenum, vanadium, boron, niobium, iron; and Example X lacks vanadium, niobium and iron. Accordingly, not one of the examples overlaps the presently claimed invention. Referring to claim 1, it is noted that only carbon, cobalt and chromium are required. Iron, boron, nickel, silicon, molybdenum, vanadium, aluminum, tantalum, tungsten, titanium, copper and columbium may be added to these constituents. Therefore, manganese is left out of this teaching.

In short, Applicant maintains it is inappropriate to contend that Way overlaps the presently claimed invention. More specifically, Way has many conflicting descriptions of his invention, and overlap occurs only if various embodiments of the invention, i.e. the specification or examples or claims, are selectively chosen from. Moreover, not one of the general teachings of the invention contained in Way overlaps the presently claimed invention. In this regard, there is no basis upon which the skilled artisan would go through the Way disclosure and select teachings from individual sections to reach the presently claimed invention absent the hindsight provided by the present disclosure.

Furthermore, Applicant's specification makes clear that the present compositions are suited for utilization in molten aluminum and/or molten zinc compositions. Accordingly, a difference in the properties of the present compositions versus Way exist. In this regard, no suggestion has been made by the Examiner why the skilled artisan would specifically select boron, molybdenum, vanadium, tungsten, and niobium from the Way list to be used in combination with one another (note this combination of constituents does not exist in any Way example). In addition, manganese is only listed in one location in Way. Accordingly, Way is not directed to an alloy for use in a molten metal environment and would not select the claimed compounds.

While the Examiner has not considered Applicant's claimed environment, the properties of Applicant's alloy must be considered when assessing whether or not a narrower claimed composition is patentable within a broad prior art description. More specifically, Applicant has claimed an alloy composition which operates in a molten metal environment. Way achieves an alloy suitable for use as a point for enlarging metal members. Importantly, Way achieves temperature resistance primarily by the inclusion of an extremely high cobalt content. In contrast, Applicant has identified a particular combination of constituents which allows for the formation of a composition suited to molten metal environments without the necessity of including very high contents of expensive cobalt (see claim 9). In this regard, in the absence of a basis for

an expectation of similar properties, a person of ordinary skill in the art would not have a sufficient basis for predicting what properties the claimed compounds would have. Ex parte Blattner 2 USPQ 2nd. 2047, (PBAI 1987). Accordingly, this provides a further distinction over what is disclosed in Way.

Furthermore, the cobalt content is too high (claim 9); the iron content is too low (claim 11); and the disclosure is silent with respect to the total of vanadium, tungsten and molybdenum (claim 1). In this regard, there is clearly no suggestion to select the particular constituents claimed by Applicant.

To further exemplify this distinction from Way, Applicant requests a higher iron content be added to claim 11, i.e. greater than about 35% by weight iron. In contrast, Way teaches less than 30% by weight iron. Applicant respectfully requests the Examiner consider the inclusion of this amendment, particularly, in view of the fact that claims 34 and 43 are inappropriately rejected in view of Way.

In view of the above, Applicant submits that this application is in condition for allowance and such action is respectfully requested.

If any fee is due in conjunction with the filing of this response, Applicant authorizes deduction of that fee from Deposit Account No. 06-0308.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as **first class mail** addressed to: Assistant Commissioner For Patents, Washington, D.C. 20231, on February 22, 1999.


Georgeen B. George